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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,707	11/24/1999	PEGGY ANN CONSTANTINO	EN999104	6599

7590

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EXAMINER

STONE, JONATHAN D

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/449,707

Applicant(s)

CONSTANTINO ET AL.

Examiner

Jonathan D Stone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. This action is responsive to communications: Application filed on 11/24/99.
2. IDS filed on 11/24/99 (paper 4).
3. Claims 1-21 are pending in the case. Claims 1, 7, and 13 are independent claims.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 1, 3, 6-7, 9, 12-13, 15, 18, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al (herein Luchs; USPN 4831526 – filing date 4/22/1986) in view of Hoyt et al (herein Hoyt; USPN 6067531 – filing date 7/21/1998) and in further view of Shirley et al (herein Shirley; USPN 5692206 – filing date 11/30/1994).***

5. **Regarding independent claim 1**, Luchs discloses an invention for creating contracts. He discloses providing for an operator to request and supplement information upon request (col 2, ln 32-37; compare with “*an entry tool...inquiry;*”). Luchs teaches the use of common application forms (col 2, ln 26-61; compare with “*one or more model agreements;*”). Luchs teaches creating a contract document by merging stored text selected by a user upon a user’s request (col 3, ln 66 – col 4, ln 16; compare with “*a document assembler...client request;*”).

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Luchs also discloses storing the contract and associated data in a repository (col 4, ln 28-31; compare with "*a repository...inquiry.*").

Luchs does not explicitly disclose processing key date reminders and approvals. However, Hoyt teaches a contract negotiator/generator that keeps track of such information. Hoyt's invention tracks approval modifications to a document, as well as the user that made the modifications and when they were made (col 7, ln 34-38; col 12, ln 46-49; col 22, ln 56-63; and col 32, ln 61-67). Additionally, Shirley teaches a contract generating invention that provides for tracking schedules, due dates, and other important dates (col 2, ln 15-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Luchs' invention to include means for tracking the approval status and important dates associated with a contract. Such a modification would have given an agent generating a contract more flexibility. Allowing a client to fill in clauses appropriate for the client and further allowing the agent to track the document's status and associated dates would have alleviated a communication burden if negotiating was necessary.

6. **Regarding dependent claim 3**, Luchs does not explicitly disclose automatically sending key date reminders to a client via e-mail. However, Hoyt discloses distributing documents to users after the status of the document is changed (col 15, ln 30-35). The use of electronic mail to distribute documents throughout a network was known and typical at the time of the invention. Shirley teaches incorporating an e-mail control unit for contract distribution (col 2, ln 57-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the tracking tool as described in the rejection of claim 1 to send documents, including tracked

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information like key dates, through e-mail means. Such a modification would have improved user interface and access by delivering important documents through familiar means.

7. **Regarding dependent claim 6**, Luchs does not explicitly disclose a library of supplemental provisions. However, Shirley discloses the use of additional provisions for generating contracts (col 2, ln 11-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the teaching of Shirley to the invention disclosed by Luchs. This would have given a user more opportunity for tailoring a contract to his or her needs.

8. **Regarding dependent claims 7, 9, and 12**, the claims incorporate substantially similar subject matter as claims 1, 3, and 6, respectively, and are rejected along the same rationale.

9. **Regarding dependent claims 13, 15, and 18**, the claims incorporate substantially similar subject matter as claims 1, 3, and 6, respectively, and are rejected along the same rationale. Additionally the claims include a computer readable medium. The use of a computer readable medium on which to store program instructions, program products, and other data was known and typical at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a computer readable medium in the invention described in the rejection of claim 1. This would have provided the invention with local access to program instructions to implement the invention as well as access to databases and storage areas.

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10. **Regarding dependent claims 19 and 21**, Luchs, Hoyt, and Shirley do not explicitly disclose recording a library of model agreements or supplemental provisions on a computer readable medium. However, it was known and typical at the time of the art to store libraries on a computer readable medium accessible to an application associated with said libraries. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the library on a computer readable medium accessible to the current invention. This would have provided a user with easy access to the libraries.

*Claims 2, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of "Frequently Asked Questions about Your Virtual Agent Network for World Wide Business" (herein VAN; Australian American Chamber of Commerce, 1996).*

11. **Regarding dependent claim 2**, Luchs does not explicitly disclose model agreements in a plurality of languages. However, VAN teaches an invention for assisting users in buying and selling goods and negotiating the exchange of said goods. VAN discloses the use of the invention in multiple languages to cater to a global market (pg 1-2 and 16-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Luchs and VAN. Such a combination would have opened the use of Luchs' contract builder to a global market, instantly increasing the breadth of the invention.

12. **Regarding dependent claims 8 and 14**, the claims incorporate substantially similar subject matter as claim 2, and are rejected along the same rationale.

***Claims 4-5, 10-11, 16-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of Grubb et al (herein Grubb; USPN 5272623 – filing date 11/7/1990).***

13. **Regarding dependent claims 4 and 5**, Luchs does not explicitly disclose a library of alternate clauses. However, Grubb discloses maintaining a database of Government Agency Regulation clauses (GARCs) for insertion into a contract document (col 2, ln 10-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the two inventions to create a contract document creator with more options for a user. A database of clauses would have given a user more opportunity for tailoring a contract to his or her needs.

Furthermore, sorting libraries was common and typical in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to organize the clause library by type. This would have presented a more logical organization for users to access and find what they needed in the library.

14. **Regarding dependent claims 10 and 11**, the claims incorporate substantially similar subject matter as claims 4 and 5, respectively, and are rejected along the same rationale.

15. **Regarding dependent claims 16 and 17**, the claims incorporate substantially similar subject matter as claims 4 and 5, respectively, and are rejected along the same rationale.

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16. **Regarding dependent claim 20**, Luchs, Hoyt, Shirley, and Grubb do not explicitly disclose recording a library of alternate clauses on a medium. However, it was known and typical at the time of the art to store libraries on a computer readable medium accessible to an application associated with said libraries. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the library on a computer readable medium accessible to the current invention. This would have provided a user with easy access to the libraries.

17. Prior art made of record and not relied upon is considered pertinent to disclosure.

Miller	U.S. Patent No. 5446653	issued 8/29/1995	filed 6/22/1994
Crawford	U.S. Patent No. 6502113	issued 12/31/2002	filed 11/23/1998
Conklin	U.S. Patent No. 6338050	issued 1/8/2002	filed 11/16/1998

Moseley, Lonnie E. and Boodey, David M. *Mastering Microsoft Office 97 Professional Edition, Second Edition* Sybex 1996, esp. pg 783-798.

### ***Conclusion***

18. Any inquiry concerning this communication from the examiner should be directed to Jonathan Stone, who can be reached by telephone at (703) 305-7854. Normal contact times are M-F, 9-5:30.

Upon an unsuccessful attempt to contact the examiner, the examiner's supervisor, Heather Herndon, may be reached at (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or faxed to:



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(703) 746-7239 (for formal communications intended for entry)


or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to

Crystal Park II, 2121 Crystal Drive  
Arlington, VA, Fourth Floor (receptionist).

Jonathan D. Stone 3/6/03

  
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